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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,091	08/01/2003	Rick Kiessig	25396-004	3397

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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT PAPER NUMBER

2167

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/632,091	Applicant(s) KIESSIG ET AL.	
	Examiner Cheryl Lewis	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-35 are presented for examination.

PRIORITY

2. Applicant has complied and receives the benefit of priority of an earlier filing date to application 60/434,418 filed December 19, 2002.

Drawings

3. Drawing figures 1 and 5 are objected to under 37 CFR 1.84(m) because they fail to show the necessary textual description stated in the drawing figures of figures 1 and 5. The textual description is not visually readable because of the black shading on the drawing figures. Section 37 CFR 1.84(m) of the MPEP states that solid black shading is not permitted. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

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made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

INFORMATION DISCLOSURE STATEMENT

4. The information disclosure statements filed on May 4, 2004, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

Specification

5. The disclosure is objected to because of the following informalities:

The applicants must provide serial numbers for the related applications indicated on page 1, paragraph [01] of the specification.

Appropriate correction is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/632,086 and unpatentable over claims 1 and 2 of copending Application No. 10/632,087. Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claim 1 of the instant application (10/632,091) contains claim limitations found in (1) independent claims 1 and dependent claim 2 of copending application 10/632,086; and (2) claim limitations found in independent claim 1 and dependent claim 2 of copending application 10/632,087.

Independent claim 1 of the instant application, 10/632,091, recites: (a) a volume manager that manages the electronic files and metadata relating to such files on one or more volumes; and (b) means for organizing the files based on the metadata; (c) wherein the metadata includes automatically generated metadata and user defined metadata.

Next, steps a and c are recited in independent claim 1 and dependent claim 2 of copending application 10/632,086

Step a is recited in independent claim 1 and step b is recited in dependent claim 2 of copending application 10/632,087.

Also, dependent claim 2 of the instant application, 10/632,091, recites: graphically displaying information about the files and the metadata; and enabling the user to manipulate the files and the metadata. This limitation is also recited in independent claim 1 of copending application 10/632,087.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1 is rejected under 35 U.S.C. 101 because claim 1 is directed to a system of managing volumes of electronic files which is an abstract idea or the mere manipulation of an abstract idea.

10. The claimed invention is directed to non-statutory subject matter because according to claim 1 the language of the claim raises a question as to whether the claim is directed to an abstract idea that is not tied to a technological art. According to the claim, a volume manager manages electronic files and metadata relating to files on one or more volumes and organizing metadata files, this is non-statutory for at least the

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reason that it is not tangibly embodied in a manner so as to be executable. It appears that the claimed method of 'a file management system for managing electronic file volumes and organizing files based on metadata is non-functional descriptive material.

Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts are more complex to analyze. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Schrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process. In practical terms, claims define nonstatutory processes if they:

- consist solely of mathematical operations without some claimed practical application (i.e, executing a "mathematical algorithm"); or
- simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

Claim 1 is not limited to tangible embodiments. To overcome this type of 101 rejection the claims need to be amended to include only tangible embodiments (e.g., 'computer implemented method comprising', processor, computer readable media,

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memory, etc.). The applicants have a practical application, however this application is not producing tangible results. As a suggestion, the applicants may consider amending the preamble of claim 1 to recite: "A computerized file management system for managing electronic files on one or more volumes, the file management system comprising."

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitka (Pat. No. 6,330,572 B1 filed July 15, 1999) and Brechner et al. (Pat. No. 6,741,996 B1 filed April 18, 2001, hereinafter Brechner).

13. Regarding Claim 1, Sitka teaches hierarchical data storage management.

The method and associated system for hierarchical data storage management as taught or suggested by Sitka includes:

a volume manager (figure 2, element 52) that manages the electronic files and metadata relating to such files (col. 17, lines 23-26) on one or more volumes (col. 14, lines 25-62).

However, Sitka does not expressly teach means for organizing the files based on the metadata, wherein the metadata includes automatically generated metadata and user defined metadata.

Brechner teaches means for organizing the files based on the metadata, wherein the metadata includes automatically generated metadata and user defined metadata (figure 10, col. 3, lines 42-46, col. 11, lines 41-67, col. 12, lines 19 & 26-57, col. 13, lines 57-67, col. 14, lines 1-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the metadata files of Sitka's method with the metadata files of Brechner's method because Brechner's metadata files could enable the metadata files of Sitka's method to comprise an automated update feature, the automated update feature enables the hierarchical collection of media clips associated with metadata files to be updated as changes to the hierarchical collection of files becomes imported files and additional files added or deleted from the collection.

14. Regarding Claim 2, Brechner teaches graphically displaying information about the files and the metadata; and enabling the user to manipulate the files and the metadata.

15. Regarding Claim 3, Brechner teaches the metadata comprises one or more tags associated with at least one of the files (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

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16. Regarding Claim 4, Brechner teaches the one or more tags comprises a name and a value (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

17. Regarding Claim 5, Brechner teaches a user interface comprises means for enabling a user to view tags (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

18. Regarding Claim 6, Brechner teaches files are classified and organized by the one or more tags (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

19. Regarding Claim 7, Brechner teaches a single file can appear in more than one folder (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

20. Regarding Claim 8, Brechner teaches folders to facilitate the categorization of content, wherein the name of a folder is used to perform a query to dynamically determine contents of the folder (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

21. Regarding Claims 9-14 and 26-33, the limitations of these claims have been noted in the rejections of claims 1, 3, 5, and 8 above. They are therefore rejected as set forth above.

22. Regarding Claim 15, Brechner teaches the categorization of content of the folders includes one of Query Search (figures 8 and figure 12 elements 350-362).

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23. Regarding Claim 16, Brechner teaches the categorization of content wherein the folders include Query folders based on tags that encapsulate search criteria and matching objects that are associated with the Query folder (figures 8 and figure 12 elements 350-362).

24. Regarding Claims 17-19 the limitations of these claims have been noted in the rejections of claims 15 and 16 above. They are therefore rejected as set forth above.

25. Regarding Claim 20, Brechner teaches the folders are combined using Boolean logic or otherwise (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

26. Regarding Claim 21, Brechner teaches a merge list of folders to be merged (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

27. Regarding Claim 22, Brechner teaches the merge occurs in real-time (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

28. Regarding Claim 23, Brechner teaches changes in related folders results in changes to the merge folder (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

29. Regarding Claim 24, the limitations of this claim has been noted in the rejection of claims 17-19 above. It is therefore rejected as set forth above.

30. Regarding Claim 25, Brechner teaches folders include Magnetic folders that disable removal if a file ever matches a query associated with the folder (col. 10, lines

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33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

31. Regarding Claim 34 and 25, Brechner teaches the means which essentially comprise the same means as an XML interface (col. 10, lines 33-64, col. 11, lines 43-67, col. 12, lines 1-53, col. 13, lines 56-67, col. 14, lines 1-67, col. 15, lines 1-55).

NAME OF CONTACT

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean Homere can be reached on (571) 272-3780. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first name "Cheryl" written in a larger, more prominent script than the last name "Lewis".

Cheryl Lewis
Patent Examiner
February 3, 2006